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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/929,184	WILCE ET AL.
	Examiner	Art Unit	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2001*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _8/14/2001, 6/23/2003, 4/1/2004,_

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Figure 12, reference number 1206 is not in the specification but is generally

described on page 31 lines 8-15.

Page 32, line 5 references display engine 1920 which should be 1902.

Appropriate correction is required.

Claim Objections

Claim 5 is objected to because of the following informalities: line 4 reads

"associated with at the first party entity" and line 7 reads "associated with at the second

party entity". Examiner interprets this as "associated with the first party entity" and

"associated with the second party entity". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

Claims 1-12, 15-19, 21-22 and 26-29 are rejected under 35 U.S.C. 102(e) as

being anticipated by Pub. No. US 2002/0087534 A1 to Blackman et al (further referred

to as Blackman).

Regarding claim 1, Blackman discloses a method for facilitating generation of an

agreement document associated with an agreement between a party and a counter-

party (page 1, paragraphs 1 and 7), comprising:

Determining agreement information (page 1, paragraphs 4 and 7);

Generating the agreement document in accordance with the agreement

information (page 1, paragraph 7); and

Arranging for the agreement document to be received by at least one of the party

and the counter-party (page 1, paragraph 7).

Regarding claim 2, Blackman discloses the method wherein said arranging

comprises automatically transmitting the agreement document via a counter-party

communication address associated with the counter-party (page 3, paragraphs 40 and

47; page 4, paragraph 62).

Regarding claim 3, Blackman discloses the method wherein the counter-party

communication address comprises at least one of: (i) an electronic mail address, (ii) an

Internet address, (iii) a uniform resource locator, and (v) a telephone number (page 4,

paragraph 62).

Regarding claim 4, Blackman discloses the method wherein said arranging comprises automatically transmitting the agreement document via a communication address associated with the party (page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 5, Blackman discloses the method wherein the party is associated with a first party entity and a second party entity (page 1, paragraph 7), and said arranging comprises:

Transmitting the agreement document via a first communication address associated with the first party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62);

Receiving information from the first party entity (page 1, paragraph 7; page 3, paragraph 47); and

Transmitting the agreement document via a second communication address associated with the second party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 6, Blackman discloses the method wherein the agreement document comprises at least one of: (i) a final agreement document, and (ii) an amendment to an existing agreement document (page 4, paragraphs 74-78; page 9, paragraph 220; page 10, paragraphs 231 and 236-237).

Regarding claim 7, Blackman disclose the method wherein the agreement document comprises a preliminary agreement document (page 1, paragraph 7; page 3, paragraph 47; page 11, paragraph 244).

Regarding claim 8, Blackman discloses the method wherein said arranging comprises automatically transmitting the preliminary agreement document via a counter-party communication address associated with the counter-party (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62), and further comprising receiving a revised preliminary agreement from the counter-party (page 4, paragraph 70-71 and 72-78; page 14, paragraph 287; page 15, paragraph 305).

Regarding claim 9, Blacker discloses the method further comprising reconciling the revised preliminary agreement document and the preliminary agreement document; and generating a final agreement document in accordance with said reconciliation (page 16, paragraph 331).

Regarding claim 10, Blackman discloses the method where said generating comprises automatically generating a plurality of agreement documents in accordance with the agreement information (page 9, paragraph 220; page 10, paragraph 236).

Regarding claim 11, Blackman discloses the method wherein the agreement

information comprises at least one of: (i) an agreement type, (ii) an agreement term,

and (iii) an agreement fact (page 3, paragraph 40; page 4, paragraph 53; page 9,

paragraph 222).

Regarding claim 12, Blackman discloses the method wherein the agreement

comprises a transaction agreement associated with at least one of: (i) a set of rights

between the party and the counter-party, (ii) a legal contract, (iii) a financial instrument,

(iv) a financial product, and (v) a monetary amount (page 1, paragraph 9).

Regarding claim 15, Blackman discloses the method wherein said determining is

performed via at least one of: (i) a covered product matrix, (ii) a pre-stored default

transaction term, (iii) information received from a user of an agreement modeling

system, (iv) information received from a satellite system, and (v) information received

from a legacy agreement system (page 1, paragraph 7; page 2, paragraph 38; page 3,

paragraphs 40 and 47).

Regarding claim 16, Blackman discloses an apparatus for facilitating generation

of an agreement document associated with an agreement between a party and a

counter-party (page 2, paragraph 38; page 3, paragraph 47), comprising:

A processor (page 2, paragraphs 12-13 and 38); and

A storage device in communication with said processor and storing instructions

adapted to be executed by said processor to (page 3, paragraphs 40-47):

Determine agreement information (page 3, paragraphs 40 and 47),

Generate the agreement document in accordance with the agreement

information (page 3, paragraph 47; page 9, paragraph 220; page 10, paragraph 236),

and

Arrange for the agreement document to be received by at least one of the

party and the counter-party (page 3, paragraph 47; page 10, paragraph 237).

Regarding claim 17, Blackman discloses the apparatus wherein said storage

device further stores an agreement information database (page 3, paragraph 40).

Regarding claim 18, Blackman discloses the apparatus further comprising a

communication device coupled to said processor and adapted to communicate with at

least one of: (i) a client device, (ii) an agreement modeling system controller, (iii) a

satellite system, and (iv) a counter-party device (page 2, paragraph 38).

Regarding claim 19, Blackman discloses a medium storing instructions adapted

to be executed by a processor to perform a method of facilitating generation of an

agreement document associated with an agreement between a party and a counter-

party (page 2, paragraph 38; page 3, paragraph 47), said method comprising:

Determining agreement information (page 3, paragraphs 40 and 47),

Generating the agreement document in accordance with the agreement

information (page 3, paragraph 47; page 9, paragraph 220; page 10, paragraph 236),

and

Arranging for the agreement document to be received by at least one of the party

and the counter-party (page 3, paragraph 47; page 10, paragraph 237).

Regarding claim 21, Blackman discloses a method for facilitating generation of

contract documents (page 2, paragraph 38; page 3, paragraph 47), comprising:

Determining contract information (page 3, paragraphs 40 and 47);

Generating a first contract document in accordance with the contract information

(page 3, paragraph 47; page 9, paragraph 220; page 10, paragraph 236); and

Generating a second contract document in accordance with the contract

information (page 9, paragraph 220; page 10, paragraph 236).

Regarding claim 22, Blackman discloses the method further comprising

automatically arranging for the first contract document and the second contract

document to be received by a party (page 3, paragraph 47; page 10, paragraph 237).

Regarding claim 26, Blackman discloses a method performed by a user to

facilitate generation of an agreement document associated with an agreement between

a party and a counter-party, comprising:

Defining agreement information (page 3, paragraph 40; page 11, paragraph 244);); and

Defining a communication address to which an agreement document will be automatically transmitted (page 3, paragraph 40; page 4, paragraph 62).

Regarding claim 27, Blackman discloses the method wherein the communication address comprises at least one of: (i) a counter-party communication address, (ii) a party communication address, and (iii) a party entity communication address (page 3, paragraph 40; page 4, paragraph 62).

Regarding claim 28, Blackman discloses the method wherein a plurality of communication addresses are defined (page 3, paragraph 40; page 4, paragraphs 62-63).

Regarding claim 29, Blackman discloses a method for facilitating negotiation of an agreement document associated with an agreement between a party and a counter-party (page 1, paragraphs 1 and 7, comprising:

Determining agreement information (page 1, paragraphs 4 and 7);

Generating the agreement document in accordance with the agreement information (page 1, paragraph 7);

Transmitting the agreement document to the counter-party in an alterable

medium (page 3, paragraph 47; page 4, paragraphs 70-71; page 10, paragraphs 236-

237); and

Receiving a revised agreement document from the counter-party (page 3,

paragraph 47; page 4, paragraphs 70-71).

Claim 20 is rejected under 35 U.S.C. 102(e) as being anticipated by Pub. No. US

2002/0188539 A1 to Axelrad et al (further referred to as Axelrad).

Axelrad discloses a computer-implemented method of facilitating generation of

an agreement document associated with a financial transaction agreement between a

party and a counter-party (page 2, paragraphs 24 and 29), comprising:

Receiving agreement information from a user associated with the party, the

agreement information including (i) a counter-party communication address (page 1,

paragraph 9; page 2, paragraph 28), and (ii) information about at least one of a financial

instrument and a financial product associated with the financial transaction agreement

(page 2, paragraph 29; page 3, paragraphs 32 and 38);

Generating the agreement document in accordance with the agreement

information and a covered products matrix (page 3, paragraph 30; page 5, paragraphs

52 and 54); and

Automatically transmitting the agreement document to the counter-party via the

counter-party communication address (page 6, paragraph 60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Blackman as applied to claim 12 above, and further in view of Pub. No. US

2002/0198833 A1 to Wohlstadter (further referred to as Wohlstadter).

Regarding claim 13, Blackman does not disclose the method wherein the

financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii)

an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan

product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative

product, (x) a commodity product, (xi) a metal product, (xii) an energy product, and (xiii)

an agricultural product.

However, Wohlstadter discloses the method wherein the financial product

comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index

product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a

whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a

commodity product, (xi) a metal product, (xii) an energy product, and (xiii) an agricultural

product (page 1, paragraph 6).

It would be obvious to one of ordinary skill in the art to combine the financial

products as disclosed by Wohlstadter with the agreement system as disclosed by

Blackman. The motivation would be that transaction agreements would include the

trading of financial products such that the impetus for developing an agreement would

be to facilitate such a transaction.

Regarding claim 14, Blackman does not disclose the method wherein at least

one transaction instrument comprises: (i) a swap instrument, (ii) an option instrument,

(iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument,

(vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x)

a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument,

and (xiii) a contract for differences instrument.

However, Wohlstadter discloses the method wherein at least one transaction

instrument comprises: (i) a swap instrument, (ii) an option instrument, (iii) a buy

instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a

forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a

repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and

(xiii) a contract for differences instrument (page 1, paragraphs 0003 and 0005).

It would be obvious to one of ordinary skill in the art to combine the transaction

instruments as disclosed by Wohlstadter with the transaction agreement system as

disclosed by Blackman. The motivation would be that transaction agreements would

include the trading of financial products to be bought, sold, traded, etc. such that the

impetus for developing an agreement would be to facilitate such a transaction.

Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Blackman, and further in view of Advanced Perl Programming by Sriram Srinivasan

(1997) (further referred to as Perl).

Regarding claim 23, Blackman discloses a method for facilitating generation of a

contract document, comprising:

Determining at least one of: (i) an agreement scope, (ii) a document scope, (iii) a

fact set scope, and (iv) a work flow scope (page 3, paragraph 40; page 11, paragraph

244); and

Generating the contract document in accordance with the result (page 3,

paragraph 30; page 5, paragraphs 52 and 54).

Blackman does not disclose placing the determined scope in a scope stack; and

evaluating the scope stack via an evaluation engine to produce a result in accordance

with at least one of (i) a rule, (ii) an action, and (iii) an expression.

However, Perl discloses placing the determined scope in a scope stack; and evaluating the scope stack via an evaluation engine to produce a result in accordance with at least one of (i) a rule, (ii) an action, and (iii) an expression (page 3, lines 36-41).

It would be obvious to one of ordinary skill in the art to combine the use of scope stacks as disclosed by Perl with the transaction agreement system as disclosed by Blackman. The motivation would be that the use of scope stacks are used to organize data related to scopes of defined fields and to use them in relation to evaluating data which has been collected and stored.

Regarding claim 24, Blackman discloses the method wherein said generating comprises generating a plurality of contract documents associated with a financial transaction agreement between a party and a counter-party (page 9, paragraph 220; page 10, paragraph 236).

Regarding claim 25, Blackman discloses the method further comprising automatically arranging for the contract document to be received by a party (page 3, paragraph 47; page 10, paragraph 237).

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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